

### **REMARKS**

Claims 1-16 and 18-33 are now pending in the application. Claims 1-33 stand rejected. Claim 17 has been canceled herein and Claims 1, 4, 5, 7-9, 12-13, 15-16, 18-20, and 22-33 have been amended herein. Support for the amendments can be found throughout the application, drawings and claims as originally filed and, as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT**

Applicant has amended Claim 20 correcting this claim's dependency on a canceled claim. No new matter has been added by this amendment. For the Examiner's convenience, the previous remarks and amendments submitted on March 27, 2008 are included herein in total.

### **CLAIM AMENDMENTS**

Applicant has non-narrowly amended the claims to clarify the subject matter of the presently pending claims. In this regard, the claims have been amended to recite a "trial bearing liner" instead of a "trial shell." Applicant respectfully submits that no new matter was added by this amendment. Applicant hopes this clarification will expedite the prosecution of this application.

#### **REJECTION UNDER 35 U.S.C. § 112**

Claims 1-3 and 5-7 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1-3 and 5-7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. These rejections are respectfully traversed.

Applicant respectfully refers the Office to paragraph [0098] of the specification as originally filed for a written description of a trial shell or bearing liner (500) that includes a plurality of attachment devices as claimed in Claims 1-3 and 5-7. Further, Applicant respectfully refers the Office to Figs. 26-27 of the drawings as originally filed for a clear illustration of the plurality of attachment devices as claimed in Claims 1-3 and 5-7. Accordingly, as support for the plurality of attachment devices can be found in the application as filed, Applicant respectfully requests the Office reconsider and withdraw the rejection of Claims 1-3 and 5-7 under 35 U.S.C. § 112, first paragraph and second paragraph.

#### **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-3, 5-7, 16-18 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by White et al. (U.S. Pat. No. 6,416,553; hereinafter "White"). This rejection is respectfully traversed.

Initially, Applicant notes that White discloses an acetabular prosthesis 10 that can include an acetabular cup 12 and a bearing liner 14. The acetabular cup 12 can include bone holes 40 for receipt of bone screws to couple the acetabular cup 12 to the

acetabulum. The bearing liner 14 can be received in the acetabular cup 12, and can act as a bearing surface for a head of a femur. In contrast, independent Claim 1 recites:

...a trial bearing liner;  
a plurality of attachment devices **defined by the trial bearing liner...**(emphasis added).

In view of the above discussion, Applicant asserts that White does not teach, suggest or disclose each and every element of Claim 1. With regard to Claim 1, White does not teach, suggest or disclose a system that can include a trial bearing liner and a plurality of attachment devices defined by the trial bearing liner. Rather, White appears to disclose an acetabular cup 12 that includes apertures for receipt of bone screws 40 to couple the acetabular cup 12 to the anatomy. Applicant notes that one of ordinary skill in the art of acetabular reconstruction would recognize that an acetabular cup is not a trial bearing liner as claimed. White does not appear to disclose a trial bearing liner, or a plurality of attachment devices defined by the trial bearing liner.

With regard to Claim 16, Applicant notes that independent Claim 16 has been amended to recite:

...a trial bearing liner defining an attachment device;...  
an acetabular cup generally defining a portion of a hollow sphere and defining a bore, said attachment member engaging said acetabular cup via said bore in said locating position and said fastened position....

As discussed, White does not appear to disclose a trial bearing liner, and White also does not appear to disclose an acetabular cup that can receive a trial bearing liner as claimed.

Accordingly, in view of at least the above discussion, Applicant respectfully submits that White does not teach, suggest or disclose each and every element of

Claims 1 and 16, and thus, Applicant respectfully requests the Office to reconsider and withdraw the rejection of Claims 1 and 16 under 35 U.S.C. § 102(e).

In addition, since Claims 2, 3, 5-7, 17, 18 and 20 depend directly or indirectly from either independent Claim 1 or 16, Claims 2, 3, 5-7, 17, 18 and 20 should be in condition for allowance for at least the reasons set forth for Claims 1 and 16 above. Accordingly, Applicant respectfully requests the Office reconsider and withdraw the rejections of Claims 2, 3, 5-7, 17, 18 and 20 under 35 U.S.C. § 102(e).

Claims 16-23 and 25-32 stand rejected under 35 U.S.C. 102(e) as being anticipated by Doursounian et al. (U.S. Patent No. 6,527,809; hereinafter "Doursounian"). This rejection is respectfully traversed.

Applicant notes that Doursounian discloses an implantable acetabulum that includes an external cap 10, an acetabular cup 16, an internal plate 25 and a trial insert 33. The external cap 10 can be coupled to the anatomy, and can receive the acetabular cup 16. The external cap 10 can include a central sleeve 14, which can have an internal thread 15. The acetabular cup 16 can include holes 18 for receipt of bone screws to couple the cup 16 to the anatomy. The cup 16 also includes a central orifice 20, which can fit over the central sleeve 14 of the cap 10 to enable the cup 16 to move angularly relative to the cap 10. The internal plate 25 can include a collar 26. The collar 26 can cooperate with the central sleeve 14, and can receive a screw 32 therethrough to couple the cup 16 to the cap 10, via the engagement of the screw 32 with the threads 15 of the central sleeve 14. Thus, the internal plate 25 can serve to lock the cup 16 to the cap 10. The insert 33 can be received within the cup 16, and can

have a central orifice 34. The central orifice 34 “[permits] access to the connecting screw 32 during the operations of adjusting the cup 16 relative to the external cap 10” (see at least Col. 3, lines 39-41). In contrast to Doursounian, independent Claim 16 has been amended to recite:

a trial bearing liner defining an attachment device;  
an attachment member moveable between a locating position and a fastened position to selectively and operably **interconnect said trial bearing liner to said acetabular prosthesis** via said attachment device; and  
an acetabular cup generally defining a portion of a hollow sphere and defining a bore, said **attachment member engaging said acetabular cup** via said bore in said locating position and said fastened position...(emphasis added).

In view of the above discussion, Applicant respectfully asserts that Doursounian does not teach, suggest or disclose each and every element of Claim 16. With regard to Claim 16, Doursounian does not teach, suggest or disclose a system that can include a trial bearing liner that defines an attachment device, an attachment member moveable between a locating position and a fastened position to selectively and operably interconnect the trial bearing liner to the acetabular prosthesis via the attachment device, or an acetabular cup in which the attachment member engages the acetabular cup. Rather, at best, Doursounian discloses the use of the screw 32 to couple the acetabular cup 16 to the external cap 10, and that the insert 33 provides access to enable an operator to manipulate the screw 32 to secure the acetabular cup 16 as desired. With regard to the Office's characterization of the cited art, the Office improperly characterizes the cup 16 of Doursounian as a trial bearing liner, in direct

contrast to the teachings of Doursounian. Applicant further notes that one of ordinary skill in the art would recognize that an acetabular cup would not be received within a trial bearing liner as suggested by the Office. Applicants also submit that it would be improper to modify Doursounian to arrive at Claim 16, as there is no evidence or suggestion of such a configuration in Doursounian (see *Ex Parte Katoh et. al.*, Appeal 20071460, Decided May 29, 2007).

Regarding Claims 19 and 23, independent Claim 19 recites:

a locking member adapted to engage said attachment member to operably couple said **attachment member and said trial bearing liner**...(emphasis added).

Independent Claim 23 has been amended to recite:

fixing said first trial bearing liner in said first orientation with an attachment member that selectively couples said first trial bearing liner to the acetabular prosthesis;

**locking the attachment member to said first trial bearing liner**...(emphasis added).

As discussed above, Applicant respectfully asserts that Doursounian does not teach, suggest or disclose each and every element of Claims 19 and 23. With regard to Claim 19, Doursounian does not teach, suggest or disclose a locking member adapted to engage the attachment member to operably couple the attachment member to the trial bearing liner. Doursounian also does not teach, suggest or disclose locking the attachment member to the first trial bearing liner as claimed in Claim 23. Rather, at best, Doursounian teaches locking the acetabular cup 16 to the external cap 10 with a screw 32 that is inserted through the internal plate 25. Further, Applicant notes it would be improper to modify Doursounian to arrive at Claims 19 and 23, as there is no

evidence or suggestion of such a configuration in Doursounian (see *Ex Parte Kato* *et al.*, Appeal 20071460, Decided May 29, 2007).

Regarding Claim 28, Applicant notes that independent Claim 28 recites:

...replacing said first trial bearing liner with a **second trial bearing liner in said implanted acetabular prosthesis** based on said determination, said second trial bearing liner having an outer dimension defining a second plane and extending at a second angle relative to said acetabular cup plane, said second angle distinct from said first angle (emphasis added).

Applicant respectfully asserts that the cited art does not teach, suggest or disclose replacing a first trial bearing liner with a second trial bearing liner as claimed. As noted by the Office, Doursounian does not teach the use of "second and third trial bearing liners" (see at least p. 4 of Office Action). Applicant further notes that none of the remaining cited art remedies this shortcoming of Doursounian, as will be discussed herein.

Accordingly, in view of at least the above discussion, Applicant respectfully submits that Doursounian does not teach, suggest or disclose each and every element of Claims 16, 19, 23 and 28, and thus, Applicant respectfully requests the Office to reconsider and withdraw the rejection of Claims 16, 19, 23 and 28 under 35 U.S.C. § 102(e). In addition, since Claims 18, 20-22, 25-27 and 29-32 depend directly or indirectly from either independent Claim 16, 19, 23 or 28, Claims 18, 20-22, 25-27 and 29-32 should be in condition for allowance for at least the reasons set forth for Claims 16, 19, 23 and 28 above. Accordingly, Applicant respectfully requests the Office to reconsider and withdraw the rejections of Claims 18, 20-22, 25-27 and 29-32 under 35 U.S.C. § 102(e).

### REJECTION UNDER 35 U.S.C. § 103

Claims 8-15, 24 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Doursonian in view of Lennox (U.S. Pat. No. 5,507,824; hereinafter "Lennox"). This rejection is respectfully traversed.

Applicant respectfully refers the Office to the remarks regarding Claims 16-23 and 25-32 for a discussion of the Doursonian reference. With regard to Lennox, Applicant notes that Lennox discloses a socket assembly 12 that includes a shell member 16 that defines a cavity 18 for receipt of a bearing liner 20. Lennox discloses the use of a single trial bearing liner prior to the insertion of the final prosthesis, as discussed in at least Col. 11. In contrast to Doursonian and Lennox, independent Claim 8 recites:

a first trial bearing liner defining a first trial bearing liner plane and defining a first attachment device;

a **second trial bearing liner** defining a second trial bearing liner plane and defining a second attachment device...(emphasis added).

Independent Claim 12 recites:

a first trial bearing liner defining a first trial bearing liner plane and defining a first attachment device;

a **second trial bearing liner** defining a second trial bearing liner plane and defining a second attachment device;...

a locking member adapted to engage said attachment member to operably **couple said attachment member and one of said first and second trial bearing liner**...(emphasis added).

In view of the above discussion, Applicant respectfully asserts that Doursounian and Lennox, singly or in combination, do not teach, suggest or disclose each and every element of Claims 8 and 12. In this regard, the cited art does not teach, suggest or



disclose a system that includes a first trial bearing liner and a second trial bearing liner as claimed in Claims 8 and 12. As noted by the Office, Doursounian does not teach, suggest or disclose the use of multiple trial bearing liners. Lennox does not remedy these shortcomings of Doursounian. Specifically, Lennox teaches the use of only one trial shell 16 prior to the insertion of the final socket member 12 in the anatomy (see at least Col. 11, lines 29-30 and lines 43-47). In addition, Applicant notes it would be improper to modify Lennox or Doursounian to arrive at Claims 8 and 12 as there is no evidence or suggestion of such a configuration in Doursounian and/or Lennox (see *Ex Parte Katoh et. al.*, Appeal 20071460, Decided May 29, 2007).

Further, with additional regard to Claim 12, none of the cited art teaches, suggests or discloses a locking member adapted to engage the attachment member to operably couple the attachment member and one of the first and second trial bearing liner as claimed. As discussed with regard to Claims 16-23 and 25-32, Doursounian does not teach, suggest or disclose a locking member as claimed. Lennox does not remedy this shortcoming of Doursounian, as Lennox also fails to teach a locking member as claimed.

Accordingly, in view of at least the above discussion, Applicant respectfully submits that Doursounian and Lennox, singly or in combination, does not teach, suggest or disclose each and every element of Claims 8 and 12, and thus, Applicant respectfully requests the Office to reconsider and withdraw the rejection of Claims 8 and 12 under 35 U.S.C. § 103(a). In addition, since Claims 9-11, 13-15, 24 and 33 depend directly or indirectly from either independent Claim 8, 12, 23 or 28, Claims 9-11, 13-15, 24 and 33 should be in condition for allowance for at least the reasons set forth for

Claims 8, 12, 23 and 28 above. Accordingly, Applicant respectfully requests the Office reconsider and withdraw the rejections of Claims 9-11, 13-15, 24 and 33 under 35 U.S.C. § 103(a).

#### **CLAIM 4**


Applicant respectfully submits that independent Claim 4 is allowable as Claim 4 is not subject to any of the above rejections. Furthermore, Applicant notes that, as discussed, the cited art does not teach, suggest or disclose a locking member as claimed in Claim 4. Accordingly, Applicant respectfully asserts Claim 4 is allowable.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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